

REMARKS

Claims 1-10, 13-21, 23-27, 29-33, 35-38, 40, 41, 50-65, 67, 68 and 129 were pending and presented for examination and in this application. In an Office Action dated April 27, 2009, claims 1-10, 13-21, 23-27, 29-33, 35-38, 40, 41, 50-65, 67, 68 and 129 were rejected. Based on the above Amendment and the following Remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections, and withdraw them.

Omnibus Rejection/Improper Final

The rejection of claims 1-7, 9, 10, 13, 15-21, 23-27, 29-33, 35, 37, 38, 40, 41, 50-65, 67, 68 and 129 is an improper omnibus rejection. The FOA rejects 15 claims as a group, then cites language from just a few. With respect to claim 1, the FOA merely recites the almost the entire text of the claim and then notes a total of 12 figures and 7 columns of text in Hartman without ever matching elements to reference portions. "A plurality of claims should never be grouped together in a common rejection, unless that rejection is **equally applicable** to all claims in the group." *See* MPEP 707.07(d) (emphasis added).

This omnibus rejection of the claims entirely, and improperly, ignored several limitations present in the claims, e.g., the limitations of independent claims 10, 29, 31-33, and 56 discussed below. Thus, Applicants submit that the current action was improperly made final. These errors substantially affect Applicants' ability to properly reply to the Final Office Action or to proceed to appeal. *See* MPEP 710.06.

Thus, Applicants request withdrawal of the finality of the Office Action.

Response to Rejection under 35 U.S.C. § 103(a)

In the Office Action, claims 1-7, 9, 10, 13, 15-21, 23-27, 29-33, 35, 37, 38, 40, 41, 50-65, 67, 68 and 129 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hartman et al., U.S. Patent No. 5,960,411 in view of Yamata, U.S. Patent No. 6,336,100. These rejections now are traversed.

Claim 1 now recites:

A method to place an order for an item at a client system, the method comprising:
providing for display at the client system information identifying the item;
providing for display at the client system an element for enabling order fulfillment instructions for ordering the identified item;
in response to receiving a first indication of selection of the element for enabling order fulfillment instructions for ordering the identified item, providing for display at the client system a plurality of order fulfillment options predefined for a user of the client system, each order fulfillment option comprising a unique combination of a delivery address, shipping instructions, and a payment source; and
in response to receiving, subsequent to the first indication, a second indication of selection of one of the plurality of order fulfillment options as a single action to order the identified item, sending to a server computer a request to order the identified item such that the identified item is to be sent to the delivery address using the shipping instructions and is to be paid for by the payment source associated with the selected one of the plurality of order fulfillment options, wherein the single action of selecting one of the plurality of order fulfillment options places the order and pays for the identified item.

A. The Cited References Do Not Disclose or Suggest A Display Element for Enabling Order Fulfillment Instructions for Ordering the Identified Item

Neither Hartman nor Yamada, alone or in combination, disclose or suggest “providing for display at the client system **an element for enabling order fulfillment instructions for ordering the identified item.**” The FOA appears to rely on Hartman for this feature, which it paraphrases as “an element representing order fulfillment instructions for the identified item.” FOA, p. 3. This paraphrasing is a misrepresentation of this claimed element. The element does not “represent” order fulfillment instructions, instead it is “for

enabling” order fulfillment instructions. In other words, the element is displayed and only once selected (e.g., as happens in the following element) are the fulfillment options displayed. Hartman discloses no such element.

Hartman shows only a purchaser information subsection 103b (FIG. 1A), as discussed in the Supplemental Examiner’s Answer (SEA), p. 4-5. The SEA quotes Hartman’s statement that button 103a can be replaced by a single-action ordering enable button, and alleges that this button anticipates this claim limitation. *Id.* This allegation represents a fundamental misunderstanding of Hartman. The single-action ordering enable button allows the user to turn on the single-action ordering feature, which allows the user to then place an order according to pre-established 1-click settings. The button does not enable display of multiple procurement options.¹ Thus, Hartman does not show this element.

Yamada does not remedy this deficiency of Hartman. Yamada’s system proceeds directly from item selection (FIG. 8) to display of stations for selection (FIG. 9), without selection of an element “**for enabling order fulfillment instructions**” as claimed. *See also* FIG. 2, step 6-7, col. 4, ll. 49-55. Thus, Yamada also does not disclose this element.

The combination also does not disclose or suggest this element, nor does the FOA allege that it does. Applicants note that as a result of the lack of this element, the references also fail to disclose the next step of “providing for display at the client system a plurality of order fulfillment options” because the claim requires that it be “in response to receiving a first indication of selection of the [above-discussed] element.” Since no element is shown, no step can be shown “in response to” selection of that element.

¹ As further evidence of this misunderstanding, the SEA alleges that 103a and 103b show “more than one fulfillment option” and discusses “pressing:” 103b. *See* SEA, p. 4-5. 103b is not selectable. Selection of 103a places the order. *Compare* Applicants’ FIG. 20, item 2003a, which produces display of the fulfillment options.

Thus, the deficient disclosures of these references, considered either alone or in the suggested combination, fail to establish even a *prima facie* basis from which a proper determination of obviousness under 35 U.S.C. §103(a) can be made. Applicants submit that claim 1 is patentably distinguishable over the cited references.

The above arguments in section A. also apply to claims 9, 67, and 68.

B. The Cited References Do Not Disclose or Suggest Display of A Plurality of Order Fulfillment Options, Each Comprising Delivery Address, Shipping Instructions, and Payment Source

The FOA alleges a combination of Hartman and Yamada for the claimed “providing for display at the client system a plurality of order fulfillment options predefined for a user of the client system, each order fulfillment option comprising a unique combination of a delivery address, shipping instructions, and a payment source.”

Specifically, the FOA points to Hartman FIG. 1C, reference numeral 108, as showing “ship to,” “shipment method,” and “payment method,” and Yamada FIG. 9 as showing two “stations” as delivery locations, and alleges that Yamada shows multiple procurement options and Hartman shows a unique combination of delivery address, shipping instructions, and payment source.

However, Yamada’s “stations” merely show plural delivery locations selectable by a user. Contrary to the assertion in the FOA that these choices “clearly correspond[] to multiple pre-defined procurement options,” they do not so correspond since the claim requires that each comprise “a unique combination of a delivery address, shipping instructions, and a payment source.” Yamada lacks at least the payment source information, and in fact provides no information about a payment method being associated with a particular station.

The FOA's reliance on Hartman for this deficiency of Yamada also is misplaced. As indicated at the top of Hartman FIG. 1C (and accompanying text at col. 5, ll. 40-43), FIG. 1C displays *a summary of combined orders*. FIG. 1C thus addresses the combining of orders that *previously* have been placed; section 108 does not provide an "option," but *mere information* pertaining to the previously-placed orders.

It is unclear to Applicants how the FOA makes the logical jump from the *mere information* provided by Hartman to using that information *as an order fulfillment option* when combined with Yamada. Indeed, to so modify Hartman would impermissibly change Hartman's principle of operation. *See In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP 2143.01 V. The purpose of the information shown in FIG. 1C is the combining of placed orders for delivery to a common address. Thus, to allow that information to become an "option" such that it is modifiable would not only not be an obvious combination/modification, it would also be undesirable, and would in fact defeat the purpose of the *order combining*, which is the context of FIG. 1C.

Thus, the deficient disclosures of these references, considered either alone or in the suggested combination, fail to establish even a *prima facie* basis from which a proper determination of obviousness under 35 U.S.C. §103(a) can be made. Applicants submit that claim 1 is patentably distinguishable over the cited references.

The above arguments in section B. also apply to claims 9, 10, 32, 33, 40, 41, and 56.

C. The Cited References Do Not Disclose or Suggest Sending a Request to Order the Identified Item in Response to Receiving Selection of One of the Plurality of Fulfillment Options

Neither Hartman or Yamada, alone or in the suggested combination, disclose or suggest "in response to receiving, subsequent to the first indication, a second indication of

selection of one of the plurality of order fulfillment options as a single action to order the identified item, sending to a server computer a request to order the identified item....”

Neither Hartman nor Yamada show sending the order request in response to selection of an order fulfillment option. Hartman shows ordering an item using a single action, e.g., clicking the Buy item button 103a, but does not disclose selection of a fulfillment option as the single action. Yamada shows selection of a “station,” but such selection, even assuming *arguendo* that it could be considered a fulfillment option, is not what triggers the order placement in Yamada. Rather, following such selection, the user must check the statement, enter a password, and click the order button. *See* Yamada, FIG. 2, steps 7-10, FIGS. 9-11 (showing the three different screens for these actions), and col. 4, l. 66 – col. 5, l. 3.

Thus, the deficient disclosures of these references, considered either alone or in the suggested combination, fail to establish even a *prima facie* basis from which a proper determination of obviousness under 35 U.S.C. §103(a) can be made.

Finally, the suggested combination of references actually teaches away from the claimed invention, because it suggests that you *either* predefine single-action settings such that sensitive information does not need to be transmitted to complete the order (*see, e.g.,* Hartman, 2:12-16; 3:66-4:3), **or** you can chose from multiple addresses for shipping, but you cannot do so through a single-action ordering process because you first need to confirm the order and your identity (*see, e.g.,* Yamada, 4:66-5:3).

Even combined, the references would need to be modified in a non-obvious way. For example, Hartman would need to be modified to change the single-ordering action step to a mere item selection step, which would need to be followed by a order fulfillment selection step. Applicants note that this modification entails more than merely reversing the order of

the selection of fulfillment information and item selection/order placement of Hartman. The standard for obviousness is not “[t]he mere fact that [the] references *can be* [] modified,” as doing so “does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” *See KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007); MPEP 2143.01 (III). Hartman provides a single-action ordering mechanism specific to a user with pre-defined 1-click settings. However, to change the 1-click settings (e.g., via button 103c of FIG. 1A), e.g., to modify the ship to, shipping address, or payment information, requires the user to login to the system via a separate webpage. *See, e.g.*, Hartman, col. 4, ll. 49-54. Thus, the suggested modification would require a complete reworking of how the ship to, shipping address, or payment information is modified in Hartman, and a webpage redesign for the 1-click ordering screen (e.g., FIG. 1A). The suggested combination thus would take the cited aspects of Hartman and/or Yamada well beyond their “established functions,” precluding the “predictability” of such combining. The discussion above indicates that the claimed invention is “more than a predictable use of [these] prior art elements according to their established functions.” *See KSR*.

Thus, Applicants submit that claim 1 is patentably distinguishable over the cited references for at least the above reasons.

The above arguments in section C. also apply to claims 9, 10, 29, 30, 32, 33, 40, 41, 50, 56, 59, 64, 67, and 68.

With respect to independent claims 10 and 32, the cited references have additional deficiencies. Specifically, claim 10 recites “for each of multiple procurement options defined for the user, providing for **display** at the client system **a distinct combination of payment information and delivery information** for ordering the item.” Neither Hartman nor

Yamada disclose displaying as a procurement option payment and delivery information.

Hartman does not display such an option for the reason described above, it further does not display an option including display of **payment information for ordering an item**.

Yamada, noted above as showing shipping address only (corresponding to a station), also does not display payment information as part of its station selection information (the corollary asserted by the FOA). Claim 32 includes similar language. Thus, claims 10 and 32 are patentably distinguishable over the cited references for this additional reason.

With respect to independent claims 29 and 31, the cited references have additional deficiencies. Specifically, claim 29 recites “providing for display at the client system one of [] multiple procurement options.” In other words, claim 29 indicates multiple procurement options, only one of which is shown. Neither Hartman nor Yamada disclose this limitation. As indicated above, Hartman does not disclose multiple procurement options, thus cannot disclose displaying for selection only one of multiple options. Yamada discloses plural stations (the alleged corollary), but does not disclose offering a single station for selection. Claim 31 includes similar language. Thus, claims 29 and 31 are patentably distinguishable over the cited references for this additional reason.

With respect to independent claim 33, the cited references have additional deficiencies. Specifically, claim 33 is a server-side claim that recites “sending to the client system ...multiple procurement options ... that each [are] **stored on the server system comprising payment information** and delivery information for a specified recipient” and “**retrieving the stored associated information** for the selected procurement option.” Neither Hartman nor Yamada disclose these limitations. As indicated above, Hartman does not disclose multiple procurement options, thus cannot disclose **a server sending multiple**

procurement options each comprising payment and deliver information, nor retrieving them. Yamada **makes no mention** of storing and/or retrieving payment information. Indeed, the only disclosure in Yamada whatsoever that appears to relate to payment is contrary to storage of such information. Yamada's FIG. 12 provides a receipt with instructions to "record receipt no. for order check." This instruction implies that the user of Yamada's system will pay for the ordered item by check, i.e., as a COD when the item is delivered. Thus, claim 33 is patentably distinguishable over the cited references for these additional reasons.

With respect to independent claim 56, the cited references have additional deficiencies. Specifically, claim 56 recites "**displaying a visual representation ...identifying an item ... an indication of a control that is selectable as a single action to order the identified item...** the **control representing one of a plurality** of multiple procurement options." Neither Hartman nor Yamada disclose this limitation. Hartman discloses indication that a control is selectable as a single action to order an item, but not that the control is one of a plurality of multiple procurement options, and a modification to add multiple procurement options would not be obvious for the reasons discussed above. Yamada does not disclose or suggest any indication of a control as a single-action ordering function of any kind. Thus, claim 56 is patentably distinguishable over the cited references for this additional reason.

Claims 2-8, 13-21, 23-27, 35-38, 51-53, 55, 57-58, 60-61, 63, 65, and 129 depend from the above-discussed independent claims, which were shown above to be patentable over the cited references and which recite additional features not shown in the cited references. For these reasons, Applicants submit that claims 2-8, 13-21, 23-27, 35-38, 51-53, 55, 57-58,

60-61, 63, 65, and 129 also are patentably distinguishable over the cited references. Claims 30, 54, and 62 are canceled.

For example, claims 17 and 37 recite limitations regarding a new procurement option displayed with, or as one of, the multiple procurement options. The FOA asserts that Hartman teaches creating of a new procurement option that can be used for placing the order. *See* FOA, p. 4 (citing Hartman, FIG. 1B, “Review or change your 1-click orders”). However, the link in section 105 of FIG. 1B of Hartman is post-order generation, and thus is not a new procurement option that could be used to place the order.

In the Office Action, claim 8 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hartman and Yamada in view of Official Notice; claims 14 and 36 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hartman and Yamada, in view of Holland et al., U.S. Patent No. 6,493,742. These rejections now are traversed.

Claims 8, 14, and 36 were shown above to be patentably distinguishable over Hartman and Yamada. Official Notice and/or Holland do not remedy the deficiencies of these references, nor does the Examiner allege that they do. Rather, Official Notice and/or Holland are cited for dependent claim limitations recited in claims 8, 14, and 36. Thus, claims 8, 14, and 36 are also patentably distinguishable over Hartman, Yamada, Official Notice and Holland.

Conclusion

In sum, Applicants respectfully submit that claims 1-10, 13-21, 23-27, 29-33, 35-38, 40, 41, 50-65, 67, 68 and 129 as presented herein, are patentably distinguishable over the

cited references. Therefore, Applicants request reconsideration of the basis for the rejections to these claims and request allowance of them.

In addition, Applicants respectfully invite the Examiner to contact Applicants' representative at the number provided below if the Examiner believes it will help expedite furtherance of this application.

Respectfully Submitted,

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By: /Jennifer R. Bush/
Attorneys for Assignee
Jennifer R. Bush, Reg. No. 50,784
FENWICK & WEST LLP
801 California Street
Mountain View, CA 94041
Phone: (650) 335-7213
Fax: (650) 938-5200